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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
08/278,601	07/21/1994	DAVID KNIPE	DFCI363A	6837	
759	90 11/05/2002				
GEORAGE W. NEUNER			EXAMINER		
P. O. BOX 9169)		MOSHER, MARY		
BOSTON, MA	02209		ART UNIT	PAPER NUMBER	
			1648	28	
			DATE MAILED: 11/05/2002	-00	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 08/278,601 Applicant(s)

Examiner

Art Unit

Mosher

1648

Knipe et al



1) Responsive to communication(s) filled on 8/15/02 2a) This action is FINAL. 2b) This action is non-final. 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. Disposition of Claims 4) Claim(s) 12-22, 31, 36, and 41 is/are pending in the application. 4a) Of the above, claim(s) is/are withdrawn from consideration. 5) Claim(s) 12-22 appear allowable, but see query in Office action is/are allowed. 6) Claim(s) 31, 36, and 41 is/are rejected. 7) Claim(s) is/are objected to. 8) Claims are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).	The MAILING DATE of this communication appears on the cover sheet with the correspondence address							
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mailing date of this communication. If the period for ripsy transferated above is less then thirty (30) days, a reply within the statutory minimum of thirty (30) days will be coinsidered timely. If NO period for ripsy is apposited above, the macinimum statutory prointed will apply and will apply apply apply apply apply apply apply and apply								
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Attachment(s) 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). 37	•		priority under 35	5 U.S.C.	§§ 120 and/or 121.			
The Market of Teleficial Cities (F10-413) Paper Notes.	_		4) 50		12) Para Na(a) 37			
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)								
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6) Other:								

Application/Control Number: 08/278,601

Art Unit: 1648

DETAILED ACTION

Interference

Interference No. I104363 has been terminated by a decision adverse to applicant. Ex parte prosecution is resumed.

Claims 1-9, 25-27, 29, 32-35, 37-40, and 42-49 stand finally disposed of in accordance with 37 CFR 1.663.

Claims 12-22, 31, 36, 41 remain pending.

Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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Claims 31, 36, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the lost interference count, in view of the abstract by Bostock (Vet. Microbiol. 23:55-71, June 1990). The interference judgment ruled that applicant was not entitled to a patent on claims 1-9, 25-27, 29, 32-35, 37-40, and 42-49. Claims 31, 36, and 41 differ from these claims only by requiring that the herpesvirus vaccine encode one or more heterologous genes. Bostock is cited as evidence that herpesvirus was known for use as a vector to encode and express heterologous genes for vaccination purposes, at the time the invention was made. Therefore, the invention of claims 31, 36, and 41 is seen as an obvious variation upon the subject matter of the lost count.

Allowable Subject Matter

Claims 12- 22 appear to be allowable, based on the record of *ex parte* prosecution in this file. However, it is noted that the file returned from interference with a copy of interference paper 108, "ORDER REDECLARING INTERFERENCE", with a footnote on page 3 that claims including 12-22, 36, and 41 "have been held unpatentable. See paper 106." Applicant is requested to provide information on how and why these claims were "held unpatentable" in *inter partes* prosecution.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is (703) 308-2926. The examiner can normally be reached on Monday -Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is now (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

October 25, 2002

MARY E. MOSHER PRIMARY EXAMINER GROUP 1809

1600

JAMES HOUSEL /1/3/c SUPERVISORY PATENT EXAMINER TECHNOLOGY CENTER 1600